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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,981	12/20/2000	Yoshikazu Kobayashi	362852/99	2679

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EXAMINER	
SCHEIBEL, ROBERT C	

ART UNIT	PAPER NUMBER
2666	7

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/738,981	Applicant(s) KOBAYASHI, YOSHIKAZU	
	Examiner Robert C. Scheibel	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4 and 5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is structured like a claim. In this case, the language of the abstract nearly identically matches that of the first claim. Applicant is requested to reword the abstract in a single paragraph and such that it clearly and concisely summarizes the main concept of the invention. Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

2. The information disclosure statement filed 6/2/2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

The applicant stated that the translated portions of the Japanese office action are sufficient for the concise explanation of relevance; however, the examiner does not believe that the submitted translation provides enough information regarding the relevance of the documents to consider them.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim **2** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "the ID received via the internet" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims **1 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,496,867 to Beser et al.

Regarding claims **1 and 10**, Beser discloses a telephone controller (network device 14 of Figure 1) controlling a plurality of telephones (represented by telephony device 24 of Figure 1) connected to the Internet (public network 12 of Figure 1) via a LAN (private network 20 of Figure 1). The telephone controller (network device 14) comprises an IP address allocating circuit which allocates a private IP address to each

of the telephones as described in step 152 of Figure 8. The network device selects a private IP address for the telephone that initiated the voice-over-IP session in Figure 5. Beser discloses the limitation of a memory in which a table indicating a correspondence between IDs of the plurality of telephones and the private IP addresses is stored in lines 28-36 of column 12. The VoIP association is the tunneling association discussed throughout Beser and is identified with an originating and terminating telephony device. This passage clearly indicates that the private IP addresses are stored in a network address table on the network device. Beser discloses the limitation of a control circuit which controls communication between the telephones and the Internet using private IP addresses in lines 19-24 of column 4 in which the network devices are described as edge routers in an exemplary embodiment. This passage indicates that these routers route packets between the public and private networks, thus controlling the communication between the telephones and the Internet (public network). Beser discloses the limitation that the ID includes a domain name in lines 38-41 and 55-57 of column 10.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims **1-3, 6 and 8-11**are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,731,642 to Borella et al in view of U.S. Patent 6,496,867 to Beser et al.

Regarding claims **1 and 10**, Borella discloses a telephone controller (gatekeeper 30 or 32 and router 18 or 20 of Figure 1) controlling a plurality of telephones (represented by caller station 24 Figure 1) connected to a LAN (edge network 14 of Figure 1). Note that in this office action, the embodiment whereby the gateway and the router are part of the same device is assumed (see lines 56-60 of column 6). Borella discloses the limitation of an IP address allocating circuit which allocates a private IP address to each of the telephones in lines 19-22 of column 9 which describes the allocation of a private IP address by the router 20. Borella discloses the limitation of a memory in which a table indicating a correspondence between Ids of the telephones and the private IP addresses is stored in the network address translation performed by the routers (see lines 49-53 of column 10 for example). In order to perform this translation, it is inherent that the router must have a table storing the association between the station ID (proxy public callee address) and the private IP address (private callee address). Borella also discloses a control circuit which controls communication between the plurality of telephones and the Internet using the private IP addresses in lines 49-53 of column 10. This explains how the router performs network address translation on the packets between the caller and callee which controls the communication between these devices over the Internet (IP Backbone media stream 12).

Borella does not disclose expressly the limitation that the ID includes a domain name of the telephone controller and identification information.

Beser discloses the limitation that the ID includes a domain name and identification information in lines 38-41 and 55-57 of column 10. Borella and Beser are analogous art because they are from the same field of endeavor of communication using IP networks. At the time of the invention, it would have been obvious to modify Borella to use the email address (including the domain name) of the user as the ID. The motivation for doing so would have been to allow easier mobility of the users as suggested in lines 57-66 of column 10. Therefore, it would have been obvious to combine Beser with Borella for the benefit of easier mobility of users to obtain the invention as specified in claims 1 and 10.

Regarding claims **2 and 11**, Borella discloses the limitation of extracting identification information and searching the table to obtain the private IP address in the network address translation described in lines 49-53 of column 10.

Regarding claim **3**, Borella discloses the limitation that the control circuit notifies the allocated IP address to the telephone in step 104 of figure 3. As described in lines 24-26 of column 9, this message includes the private callee address.

Regarding claim **6**, Borella discloses the limitation that the memory stores a table indicating communication history information for each ID in lines 14-15 of column 8. Here, Borella explains that the gatekeeper will store the private caller address in order to determine billing information (which requires a history of the communication information).

Regarding claim **8**, Borella discloses the means for receiving the ID wherein the control circuit stores the ID received from said means in the allocate address messages of Figure 3. These messages contain ID information which are inherently received (transferred from one device to another) and are inherently stored (as discussed above in order to use this information to perform the network address translation).

Regarding claim **9**, Borella discloses the limitation of the transfer circuit which transfers information stored in the table to some other telephone controller in the gatekeeper setup message 92 of Figure 3. As described in lines 45-52 of column 8, this message includes caller and callee identification information (stored in the table) from one telephone controller (first gatekeeper) to another telephone controller (second gatekeeper).

9. Claims **4-5 and 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,731,642 to Borella et al in view of U.S. Patent 6,496,867 to Beser et al as applied to parent claim 1 under 35 USC 103(a) above, and further in view of U.S. Patent 6,400,719 to Chimura et al.

Regarding claim **4**, the limitations of the parent claim 1 are disclosed by Borella and Beser as addressed above. Borella and Beser do not disclose expressly the limitation of claim 4 of the identification information being composed of a user name and an extension telephone number. Chimura discloses the limitation of identification information being composed of a user name (host name) and extension telephone number (office number) in lines 52-54 of column 5. Borella, Beser, and Chimura are

analogous art because they are from the same field of endeavor of communication using IP networks. It would have been obvious to modify Borella, as modified above, to store the telephone extension and user name in a table. The motivation for doing so is so that the host name associated with the office number can be used to access a DNS server to determine the location of the gateway serving that host as described in the abstract. Therefore, it would have been obvious to combine Chimura with Borella and Beser for the benefit of using a standard DNS server to obtain the invention as specified in claim 4.

Regarding claim **7**, with the limitations of parent claim 4 addressed above, Borella discloses the limitation of the table being updated in response to a request from the telephone in Figure 3. The telephone initiates the sequence with the initial setup which ends up in the table in the router being updated to support the network address translation discussed above.

Regarding claim **5**, the limitations of the parent claim 1 are disclosed by Borella and Beser as addressed above. Borella and Beser also disclose the memory containing a table relating the ID and the private IP address in the network address translation discussed above. Borella and Beser do not disclose expressly the limitation of claim 5 of the memory storing a table indicating the correspondence among the extension and user name in addition to the ID and private IP address. Chimura discloses the limitation of the table including additionally a user name (host name) and extension telephone number (office number) in Figure 4. Borella, Beser, and Chimura are analogous art because they are from the same field of endeavor of communication

using IP networks. It would have been obvious to modify Borella, as modified above, to store the telephone extension and user name in a table. The motivation for doing so is so that the host name associated with the office number can be used to access a DNS server to determine the location of the gateway serving that host as described in the abstract. Therefore, it would have been obvious to combine Chimura with Borella and Beser for the benefit of using a standard DNS server to obtain the invention as specified in claim 4.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,128,664 to Yanagidate et al, U.S. Patent Application Number US 2002/0191576 to Inoue et al, U.S. Patent 6,563,824 to Bhatia et al, and U.S. Patent 6,683,871 to Lee et al all disclose methods for using private IP addresses to communicate with devices on external networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 703-305-9062. The examiner can normally be reached on 6:30-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 703-308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RCS 5-20-04

Robert C. Scheibel
Examiner
Art Unit 2666

Seema S. Rao 5/25/04

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